



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,654	10/24/2003	H. Donald Schwartz	D0419.70008US00	9919

7590 05/11/2006

David Wolf
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

EXAMINER

RAEVIS, ROBERT R

ART UNIT	PAPER NUMBER
----------	--------------

2856

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/692,654

Applicant(s)

SCHWARTZ, H. DONALD

Examiner

Robert R. Raevis

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 45 and 46 is/are rejected.
- 7) ☒ Claim(s) 5, 6, 47 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4-21-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 1-4,45,46 are rejected under 35 U.S.C. 102(e) as being anticipated by Bach.

As to claims 1,3, the provisional application of Bach teaches (Figure 4) a block (Cylinder-Upper) having a passage extending therethrough; a rod (Primary Piston), that passes into the channel block passage; a cylinder (Secondary Piston) having an axially extending passage supporting a spring, the cylinder passing into the block from the end opposite the end into which the rod passes; a chamber defined by the inside wall of the block, the outer perimeter of the rod, the outer perimeter of the cylinder, and having a volume which is variable during the pipetting ("pipettor" on the fourth line of the first page of the written specification of the provisional) operation of the pipette, with a first part of the chamber being variable by relative movement of the block relative to the fixed relative positions of the rod and cylinder (note the "secondary piston can follow the primary piston" (lines 3-4 from bottom of p. 1 of provisional application), suggestive that the rod and cylinder are moving together relative to the block)), and with a second part of the chamber variable by *additional* movement of the cylinder relative to the fixed position of the block (both the rod and cylinder are still in contact as they move upwards relative to the block) and by even additional movement of the cylinder relative to the fixed position of the rod (as the rod moves away from the cylinder, while both the cylinder and block are both stationary relative to the moving rod). In effect, the "variable" (line 2 from last of Claim 1) portion of the "second part of the chamber" is not related to the "fixed relative positions" in a manner that defines the claim from Bach.

(Note that Applicant's claim 47 (specifically, "entirely") is conclusive evidence that claim 1's "therethrough" (on line 4 of claim 1) may not be interpreted as meaning entirely therethrough.

As to claim 2, note that when the rod moves relative to fixed positions of the block and cylinder, that the pump volume may increase, allowing for a third part.

As to claim 4, note the vertically oriented groove in the rod in Figure 4, the groove connecting "Inlet Port" with the remaining volume of the liquid in the block. At least the diameter of the rod at this point is less than that of the inner diameter of the channel block.

As to claim 45, the rod does not extend into the cylinder in Figure 4.

As to claim 46, note that the spring is in the passage that is axially through the cylinder.

Regarding Applicant's **REMARKS**, consider the following:

As to pages 4-5, Claim 1 does not priority back to May 22, 2003. While the parent does have a housing 60, rod and cylinder; those elements in the parent do not provide for "a first part of the chamber variable by relative movement of the channel block relative to the fixed relative positions of the rod and cylinder, and with a second part of the chamber variable by relative movement of the cylinder relative to the fixed relative positions of the rod and channel block" (last 4 lines of claim 1) as called for in claim 1. This is due to the wiper seal 28 of the parent that does **not** permit for the claimed variation of that part of the chamber, in contrast with Figures 6B and 6C of the

application which illustrate that lack of a seal at the top end of the cylinder permits 320 for a variation of that part of the cylinder. **In the event that Applicant disputes this, please direct the Undersigned to both *specific* figures and *specific* portions of the written specification of the parent.**

Claims 5,6,47,48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert R. Raevis whose telephone number is 571-272-

Art Unit: 2856

2204. The examiner can normally be reached on Monday to Friday from 5:30am to 3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Williams', with a long horizontal line extending to the right.

RAZUS